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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,783	01/04/2001	Hidefumi Kondo	FUJY 18.187	3232

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EXAMINER
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BATES, KEVIN T

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/754,783

Applicant(s)

KONDO ET AL.

Examiner

Kevin Bates

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

The Foreign Priority Documents were received on January 4, 2001.

The Information Disclosure Statement was received on January 4, 2001.

The Preliminary Amendment was received on January 4, 2001.

The Sub-Power of Attorney was received on January 4, 2001.

The Change of Address was received on November 27, 2002.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolf (5818447).

Regarding claim 1, Wolf discloses an electronic mail system comprising: a transmission apparatus (Column 2, lines 12 – 24) including; first storing means for holding a signature of an electronic mail by associating it with identification information (Column 17, lines 27 – 34); identification information reading out means for reading out from said first storing means identification information corresponding to a signature included in an electronic mail to be transmitted (Figure 11, element 1125 and 1120); converting means for converting the signature of said electronic mail to the identification information read out by the identification information reading out means; and transmitting means for transmitting said electronic mail with its signature part being

converted to the identification information by said converting means to its destination (Column 2, line 65 – Column 3, line 22); and a reception apparatus (Column 15, line 53 – Column 16, line 9) including; second storing means for holding a signature of an electronic mail by associating it with identification information (Column 16, lines 45 – 55); receiving means for receiving an electronic mail transmitted from said transmission apparatus (Column 20, lines 36 – 39); signature reading out means for reading out from said second storing means a signature corresponding to the identification information included in said electronic mail received by said receiving means; and restoring means for converting the identification information included in the electronic mail to the signature read out by the signature reading out means (Column 16, lines 45 – 55).

Regarding claim 7, Wolf discloses a transmission apparatus of an electronic mail (Column 2, lines 12 – 24) comprising: storing means for holding a signature of an electronic mail by associating it with identification information (Column 17, lines 27 – 34); identification information reading out means for reading out from said storing means identification information corresponding to a signature included in an electronic mail to be transmitted (Figure 11, element 1125 and 1120); converting means for converting the signature of said electronic mail to the identification information read out by the identification information reading out means; and transmitting means for transmitting said electronic mail with its signature part being converted to the identification information by said converting means to its destination (Column 2, line 65 – Column 3, line 22).

Regarding claim 8, Wolf discloses a reception apparatus of an electronic mail (Column 15, line 53 – Column 16, line 9) comprising: storing means for holding a signature of an electronic mail by associating it with identification information (Column 16, lines 45 – 55); receiving means for receiving an electronic mail transmitted by said transmission apparatus (Column 20, lines 36 – 39); signature reading out means for, if identification information of a signature is included in said electronic mail received by said receiving means, reading out a signature corresponding to the identification information from said storing means; and restoring means for converting the identification information included in said electronic mail to the signature read out by said signature reading out means (Column 16, lines 45 – 55).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf in view of Beyda (6505237).

Regarding claim 2, Wolf discloses that first storing means and said second storing means hold a signature and identification information (Column 16, lines 45 – 55), but Wolf does not explicitly indicate corresponding to the signature by associating them with a sender's mail address of an electronic mail. Beyda teaches corresponding to the

signature by associating them with a sender's mail address of an electronic mail (Column 4, lines 42 – 52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Beyda's idea of corresponding attachment files, or the extracted, embedded files in Wolf's system with the sender's address in order to allow the receiver to have better control over determining actions that can be taken in response to an email with attached or embedded files (Column 2, lines 31 – 44).

Regarding claim 3, Wolf does not explicitly indicate that said transmission apparatus further includes extracting means for, when contents held by said first storing means are renewed, extracting information concerning the renewal as renewal information, and transmits said renewal information; and said reception apparatus further includes renewing means for, when said receiving means receives said renewal information, renewing contents held by said second storing means in accordance with said renewal information. Beyda's mail system discloses where when the attachment files have been modified or renewed to allow the updated attached file or embedded object to be renewed on the system (Column 8, lines 30 – 50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Beyda's teaching of reducing the number of times an attachment is transmitted to a client by only updating the attachment or embedded file when there has been a modification taken place (Column 2, lines 15 – 28).

Regarding claim 4, the combination of Wolf and Beyda as seen in claim 3 discloses that said transmitting means transmits an electronic mail having renewal

information including a signature registered anew in said first storing means and identification information allocated to this signature, and said renewing means renews contents held by said second storing means in accordance with said renewal information included in said electronic mail received by said receiving means (Beyda, Column 8, lines 30 – 50).

Regarding claim 5, the combination of Wolf and Beyda as seen in claim 3 discloses said electronic mail is an electronic mail for renewing the contents of said second storing means (Beyda, Column 8, lines 30 – 50).

Regarding claim 6, the combination of Wolf and Beyda as seen in claim 3 discloses said electronic mail is an electronic mail with a signature registered anew in said first storing means and identification information corresponding to the signature being added to an electronic mail to be transmitted to said reception apparatus (Beyda, Column 8, lines 30 – 50).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent No. 6510453 issued to Apfel, because it teaches the use of complex signatures.

U. S. Patent No. 6275848 issued to Arnold, because it teaches the idea of deciding whether to transmit a file attachment or not.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Bates whose telephone number is (703) 605-0633. The examiner can normally be reached on 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KB

KB  
June 24, 2004

  
PATRICE WINDER  
PRIMARY EXAMINER